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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/621,927	07/17/2003	Paul Anthony Ashley	AUS920030169US1	3074

			EXAMINER
32329 7590 01/09/2007 IBM CORPORATION INTELLECTUAL PROPERTY LAW 11400 BURNET ROAD AUSTIN, TX 78758			HOFFMAN, BRANDON S

ART UNIT	PAPER NUMBER
2136	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

	Application No.	**Applicant(s)**
Office Action Summary	10/621,927	ASHLEY ET AL.
	Examiner	**Art Unit**	
	Brandon S. Hoffman	2136	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL.** 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-33* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *17 July 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date *7-17-03 & 2-11-05*.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1.   The information disclosure statement (IDS) submitted on February 11, 2005, is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

2.   The information disclosure statement filed July 17, 2003, fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because the Japanese reference (2001-237820A) is missing from the application file, and therefore cannot be considered. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a). The other references, filed in the July 17, 2003 IDS, have been considered.

Claim Rejections - 35 USC § 101

3.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4.   Claims 21-30 and 33 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 21-30 and 33 are not

limited to tangible embodiments. In view of applicants' disclosure, specification, page

29, lines 26-30, the medium is not limited to tangible embodiments, instead being

defined as including both tangible embodiments (e.g., EPROM, floppy disc) and

intangible embodiments (e.g., transmission-type media, communications links). As

such, the claim is not limited to statutory subject matter and is therefore non-statutory.

Claim Rejections - 35 USC § 102

5.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6.   Claims 1-9, 11-19, 21-29, and 31-33 are rejected under 35 U.S.C. 102(b) as

being anticipated by Joshi et al. (U.S. Patent Pub. No. 2002/0091798).

Regarding claims 1, 11, and 21, Joshi et al. teaches a

method/apparatus/computer program product in a computer-readable medium for

performing authentication operations, the method/apparatus/computer program product

comprising:

- Performing a non-certificate-based authentication operation through an SSL

  (Secure Sockets Layer) session between a server and a client (paragraph 0144,

  0145, and fig. 33, the authentication scheme sets an SSL parameter to enable

  SSL for the challenge method being used); and

- Subsequent to performing the non-certificate-based authentication operation, performing a certificate-based authentication operation through the SSL session between the server and the client without exiting or renegotiating the SSL session prior to completion of the certificate-based authentication operation (paragraph 0144, 0145, and fig. 35, the X.509 challenge method uses certificates for authentication over an SSL connection).

Regarding claims 2, 12, and 22, Joshi et al. teaches wherein negotiation of the SSL session uses a first digital certificate from the client, wherein the certificate-based authentication operation uses a second digital certificate from the client, and wherein the first digital certificate and the second digital certificate are not identical (paragraph 0204 and fig. 35, ref. num 1352 and 1356).

Regarding claims 3, 13, and 23, Joshi et al. teaches further comprising providing access to a first resource for a client by a server in association with the non-certificate-based authentication operation (fig. 22, ref. num 795).

Regarding claims 4, 14, and 24, Joshi et al. teaches wherein the step of providing access to the first resource further comprises:

- Receiving at the server a first resource request from the client (fig. 22, ref. num 750);
- In response to determining that the first resource request requires completion of a non-certificate-based authentication operation prior to responding to the first

resource request, establishing an SSL (Secure Sockets Layer) session between

the server and the client (fig. 22, ref. num 756); and

- In response to successfully performing the non-certificate-based authentication

  operation between the server and the client through the SSL session, sending a

  first resource response from the server to the client (fig. 22, ref. num 790, 792,

  794, and 795).

Regarding claims 5, 15, and 25, Joshi et al. teaches further comprising providing

access to a second resource for a client by a server in association with the certificate-

based authentication operation (fig. 35).

Regarding claims 6, 16, and 26, Joshi et al. teaches wherein the step of

providing access for the second resource further comprises:

- Receiving at the server a second resource request from the client through the

  SSL session (fig. 35, ref. num 1348);

- In response to determining that the second resource request requires a

  certificate-based authentication procedure, downloading an executable module to

  the client from the server through the SSL session (paragraph 0202);

- Receiving at the server a digital signature that has been generated by the

  executable module using a digital certificate at the client (fig. 35, ref. num 1360-

  1364); and

- In response to successfully verifying the digital signature at the server, sending a

  second resource response from the server to the client (fig. 35, ref. num 1366).

Regarding <u>claims 7, 17, and 27</u>, <u>Joshi et al.</u> teaches wherein the step of

providing access for the second resource further comprises:

- Receiving at the server a second resource request from the client through the

  SSL session (fig. 35, ref. num 1348);

- In response to determining that the second resource request requires a

  certificate-based authentication procedure, triggering execution of a

  downloadable software module at the client by the server through the SSL

  session (paragraph 0204);

- Receiving at the server a digital signature that has been generated by the

  execution of the downloadable software module using a digital certificate at the

  client (fig. 35, ref. num 1360-1364); and

- In response to successfully verifying the digital signature at the server, sending a

  second resource response from the server to the client (fig. 35, ref. num 1366).

Regarding <u>claims 8, 18, and 28</u>, <u>Joshi et al.</u> teaches further comprising obtaining

access to a second resource at a server by a client in association with the certificate-

based authentication operation (fig. 35, ref. num 1366).

Regarding <u>claims 9, 19, and 29</u>, <u>Joshi et al.</u> teaches wherein the step of

obtaining access to the second resource further comprises:

- Sending a second resource request from the client to the server through the SSL

  session (fig. 35, ref. num 1348);

- Receiving an executable module at the client from the server through the SSL session, wherein the executable module comprises functionality for performing a certificate-based authentication operation (paragraph 0203);

- Sending to the server through the SSL session a digital signature that has been generated by the executable module using a digital certificate at the client (); and

- Receiving a second resource response from the server at the client (fig. 35, ref. num 1366).

Regarding claims 31-33, Joshi et al. teaches a method/apparatus/computer program product in a computer-readable medium for performing authentication operations, the method/apparatus/computer program product comprising:

- Receiving at a server a first resource request from a client (fig. 22, ref. num 750);

- In response to determining that the first resource request requires completion of a non-certificate-based authentication operation prior to responding to the first resource request, establishing an SSL (Secure Sockets Layer) session between the server and the client (fig. 22, ref. num 756);

- Performing a non-certificate-based authentication operation through the SSL session (fig. 22, ref. num 790-794);

- In response to successfully performing the non-certificate-based authentication operation, sending a first resource response from the server to the client (fig. 22, ref. num 795);

- Receiving at the server a second resource request from the client through the SSL session subsequent to performing the non-certificate-based authentication operation (fig. 35, ref. num 1348);

- In response to determining that the second resource request requires a certificate-based authentication procedure, downloading an executable module to the client from the server through the SSL session (paragraph 0202);

- Receiving at the server through the SSL session a digital signature that has been generated by the executable module using a digital certificate at the client (fig. 35, ref. num 1360-1364); and

- In response to successfully verifying the digital signature at the server, sending a second resource response from the server to the client (fig. 35, ref. num 1366).

Claim Rejections - 35 USC § 103

7.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8.   Claims 10, 20, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joshi et al. (U.S. Patent Pub. No. 2002/0091798).

Regarding claims 10, 20, and 30, Joshi et al. teaches wherein the step of obtaining access to the second resource further comprises:

- Sending a second resource request from the client to the server through the SSL session (fig. 35, ref. num 1348);

- Sending to the server through the SSL session a digital signature that has been generated by the executable module using a digital certificate at the client (fig. 35, ref. num 1360-1364); and

- Receiving a second resource response from the server at the client (fig. 35, ref. num 1366).

Joshi et al. fails to specifically teach receiving at the client from the server through the SSL session a response message having content with an associated content type indicator and in response to determining a content type for the content, executing a downloadable software module at the client. However, Official Notice is taken that these steps would have been obvious, given the nature of the teachings of Joshi et al. because the content type indicator tells the client browser which content type is being used, and further enables the client browser to load the appropriate plug-in to play/view the requested content type.

It would have been obvious for such modifications because detecting a specific content type allows the appropriate plug-in to be loaded to ensure proper operation and lower the amount of user frustration over trying to figure out which plug-in should be loaded for each resource request.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brandon S. Hoffman whose telephone number is 571-272-3863. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser G. Moazzami can be reached on 571-272-4195. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.
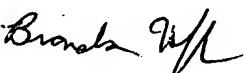
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